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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/722,345	09/27/96	WATKINS	

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C2M1/0724

EXAMINER

FILED IN	ART UNIT	PAPER NUMBER
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3208

DATE MAILED: 07/24/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a storage and retrieval bag, does not reasonably provide enablement for each and every equivalent means for storing and retrieving feminine sanitary napkins. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make each and every equivalent storage and retrieval means equivalent to the invention commensurate in scope with these claims. Claim 1 is what is referred to as a "single means claim".¹

¹ MPEP 2164.08(a), Single Means Claim,

"A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in Fiers v. Sugano, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim."

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3. Claim 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A portable/hangable utility device is recited that is indefinite. It is unclear if the device is portable or hangable. The scope of the single means recited is unclear.

Additionally claim 2 employs alternative language as a handle and/or strap. Is applicant claiming a handle or a strap? Or a handle and a strap? The phrase "or the like" renders the claim indefinite because the claimed apparatus includes elements not actually disclosed (those encompassed by "or the like") and the scope of the claim is unascertainable. *Ex parte Caldwell*, 1906 CD 58 (Commr Pats 1905). While the claim has the proper beginning format, the body of the claim includes periods which is not permitted. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim", "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. >See *Fressola v. Manbeck*, (D.D.C. 1995).< A claim may be typed with the various elements subdivided in paragraph form.²

In addition to the above, claim 3 additionally improperly uses a means plus language where the "same" means does not modify the means recited. The use of the word "means" without an accompanying function renders a claim indefinite, *Ex parte Klumb*, 159 U.S.P.Q. 694.

The second paragraph of 35 U.S.C. 112 requires a claim to particularly point out and distinctly claim the subject matter which applicant regards as his or her invention. Under *In re Hammack*, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others

²MPEP 608.01(m)

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who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (PTO Bd. Pat. App. & Intf. 1989).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by McMAHAN '412. A portable/hangable utility means (box "A") for the storage and retrieval of feminine sanitary napkins is disclosed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARNOLD '898 in view of PRIMLEY '565. In figure 1 ARNOLD '898 discloses an utility bag comprising a rectangular main housing having a top access opening provided by flaps 14, 15. The bag is considered a means for the storage and retrieval of sanitary napkins to the extent that these items can be placed within the bag. A side access opening is provided by the flap 16 and the top panel 14 has a band, not numbered, located thereon. ARNOLD '898 discloses the claimed combination except for the strap and/or handle, and one or more pockets secured to outside. PRIMLEY '565 discloses that it well known in the portable carrier art to provide bags with straps 13 and outside pockets as shown in figure 1. It would have been obvious to one of ordinary skill in the art to modify the toiletry article carrier of ARNOLD '898 by providing as strap and outside pockets as taught by PRIMLEY '565, in order to permit suspension and/or carrying of the case while provide for greater holding capacity of an assortment of articles.

ARNOLD '898 additionally discloses the claimed invention except for a plurality of bands as opposed to a band affixed to the inner side of the lid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of bands, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As to claim 3, the dimensions of the housing are entirely dependent upon how big, or small one desires to construct something. It would have been an obvious matter of design choice to dimension the case to store one full consumer size package of sanitary napkins, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. If applicant continues to prosecute the application, revision of claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

11. Telephone inquiries regarding the status of applications, whether or not certain papers have been received or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners",
M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148, the Group Fax number is (703) 305-3579.

12. Inquiries concerning the merits of the examination should be directed to Mr. Fidei whose telephone number is (703) 308-1220.

dtf
July 18, 1997


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